IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

TANGELO IP, LLC, Plaintiff, v. WAL-MART STORES, INC., WAL-MART.COM, INC., and WAL-MART.COM USA, LLC Defendants.	)))))))))))))	Case No. 2:15-cv-01697-JRG **JURY TRIAL DEMANDED**

WAL-MART STORES, INC. AND WAL-MART.COM USA, LLC'S[1] MOTION TO DISMISS PURSUANT TO FED. R. CIV. P. 12(b)(6) AND 35 U.S.C. § 101

[1] The caption, incorrectly names as a Defendant "Wal-Mart.com, Inc.," which does not exist. Wal-Mart has informed Tangelo of this error. Wal-Mart expressly reserves all rights and defenses in this matter resulting from the deficiencies in Tangelo's Complaint that are not promptly corrected.

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I. INTRODUCTION

U.S. Patent No. 8,429,005 ("'005 patent") is a textbook case of claims being directed to an abstract idea that do not recite an inventive concept.[2] At their heart, the claims of the '005 patent are directed to providing a replication of a printed publication that allows a user to obtain additional information about its content. This is not a new concept. For decades, retailers have sent catalogs that allow users to obtain additional information about the products from telephone sales representatives, and publishers of classic literature have provided compendiums of helpful information to dissect difficult prose. The '005 patent merely claims this abstract idea with the routine steps of "associating," "receiving," and "providing" the replicated content on generic, "conventional" computers.

Moreover, the patent repeatedly admits that the technology and computer components performing the steps are "conventional" and known in the art. Simply applying this abstract idea in the context of an online product catalog fails to provide an "inventive concept" necessary to transform this abstract idea into patent-eligible subject matter under Supreme Court precedent. Because the patentability of the claims is a question of law that does not depend on discovery or turn on claim construction issues, judgment on the pleadings is warranted and would avoid further unnecessary drains on the resources of the Court.[3]

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[2] The same motion is simultaneously being filed in the following cases in the Eastern District of Texas: *Tangelo IP, LLC v. Euromarket Designs, Inc. et al.*, No. 2:15-cv-01693; *Tangelo IP, LLC v. HD Supply, Inc. et al.*, No. 2:15-cv-01694; *Tangelo IP, LLC v. Mary Kay Inc.*, No. 2:15-cv-01695, *Tangelo IP, LLC v. New Moosejaw, LLC*, No. 2:15-cv-01696, and *Tangelo IP, LLC v. Wal-Mart Stores Inc. et al.*, No. 2:15-cv-01697.

[3] Whether a claim recites patent-eligible subject matter under Section 101 is properly resolved on a Rule 12(b)(6) motion. *See, e.g., Ultramercial v. Hulu, LLC,* 772 F.3d 709, 713, 717 (Fed. Cir. 2014) (affirming district court's order granting defendants' Rule

II. STATEMENT OF THE ISSUES

The only asserted patent is invalid as directed to non-patentable subject matter under Section 101 of the Patent Act, and the complaint should be dismissed under Rule 12(b)(6) for failure to state a claim upon which relief may be granted.

III. THE ’005 PATENT

The ’005 patent was filed on June 11, 2003, and allegedly claims priority to an application filed September 23, 1999. *See* Decl. of Bijal V. Vakil (“Vakil Decl.”) Ex. 1,’005 patent; Complaint, Dkt. 1, at ¶ 13. The ’005 patent recites the alleged problem with the prior art: traditional print media “does not provide the depth of content permitted by electronic files,” and users may be unable “to locate additional information about objects shown in” traditional print media. Vakil Decl. Ex. 1, at 1:43-52, 2:11-14. The ’005 patent attempts to address the issue by providing an “interactive electronic representation” of a physical publication to a user. *See, e.g.,* Vakil Decl. Ex. 1, at claim 1; Dkt. 1, at ¶ 14.

The patent contemplates that there is first, a physical publication, referred to as a “visual media object,” that can include portions of “magazines, catalogs, newspapers, pamphlets … [and] video cassettes and discs.” *See* Vakil Decl. Ex. 1, at 11:12-19. An electronic replication of the physical publication is created “by using a scanner, a digital camera, or software” to capture the publication in a digital format. *Id*. at 4:60-67. This “electronic replication” is provided to the user. *See, e.g., id*. at claim 1. By interacting with this electronic replication, a customer can obtain additional product information. *See, e.g., id*. at 3:39-42, Figure 5 (reproduced below); Dkt. 1, at ¶ 14.

12(b)(6) motion finding the asserted claims ineligible under Section 101).

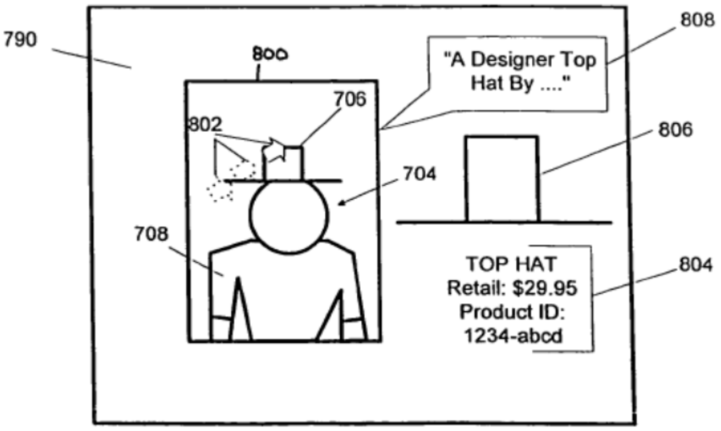

FIG. 5

The claims of the patent recite the steps of (1) ***associating*** a page number between the "electronic replication" and the "physical publication," (2) a "host computer" ***receiving*** the associated page number, and (3) the "host computer" ***providing*** an "electronic replication" of the "physical publication" in response to receiving the page number. *See* Vakil Decl. Ex. 1, at 33:34-36, 33:43-48. The "electronic replication" that is displayed allows the user to "obtain the additional information" about the products contained in the "electronic replication." *Id.* at 33:57-67. Representative claim 1 provides: [4]

> 1. A method for providing to a user an interactive and electronic replication of at least a portion of a corresponding physical publication page, comprising:
> ***(1) associating*** a page number of a physical publication page with an interactive and electronic replication of at least a portion of a physical publication page;
> the physical publication page having at least two different products appearing on the physical publication page;
> the page number appearing on the physical publication page along with

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[4] Courts regularly use a representative claim to analyze step one of *Alice* where the claims all "recite little more than the same abstract idea." *See, e.g., Content Extraction & Transmission LLC v. Wells Fargo Bank*, 776 F.3d 1343, 1348 (Fed. Cir. 2014) (affirming invalidation of four patents with a total of 242 claims based on analysis of representative claims); *see also Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2359-2360 (2014) (analyzing "representative" method claims to invalidate all claims, including corresponding system and computer-readable media claims that "add nothing of substance to the underlying abstract idea").

the at least two different products;
the page number and the two different products being visible on the physical publication page;

(2) receiving by a host computer comprising at least one computer processor an input representing the page number;

(3) providing from the host computer the interactive and electronic replication of the at least a portion of the physical publication page in response to receiving the input representing the page number;

the interactive and electronic replication of the at least a portion of the physical publication page including duplications of the appearances of the at least two different products;
the duplications of the appearances of the at least two different products being exact reproductions of the appearances of the at least two different products contained within the physical publication page;
the interactive and electronic replication enabling the user to obtain additional information on the at least two different products contained within the interactive and electronic replication; and
wherein the user is able to see the interactive and electronic replication and the at least two different products in the physical publication page and can obtain the additional information on the at least two different products contained within the interactive and electronic replication of the at least a portion of the physical publication page by receiving the interactive and electronic replication.

The patent contemplates that the steps can be performed on a "conventional" personal computer – a "host computer" – executing "conventional" applications. *See, e.g., id.* at 8:38-48, 9:28-33, 10:48-11:9. The "host computer" may be connected to a networked environment, such as the Internet, that is "commonplace in offices" and known to those skilled in the art. *Id.* at 10:5-16; 13:59-64. However, the patent touts that the claims are not "limited to any particular computer or apparatus." *Id.* at 9:10-12, 10:48-50. In fact, the patent expansively states that a computing device is not even necessary to perform the steps and a "voice network," such as a telephone, can provide the "representation of the visual media object to the user." *Id.* at 4:44-47, 4:53-54.

IV. ARGUMENT

The Supreme Court recently clarified that courts should analyze patent-eligibility using a two-part framework. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014); *see also eDekka LLC v. 3Balls.com, Inc.*, No. 2:15-cv-00541, 2015 WL 5579840, at *3 (E.D. Tex. Sept. 21, 2015) (Gilstrap, J.) (recognizing that patent eligibility under Section 101 is determined by applying the two-step test articulated and reaffirmed in *Alice*). The first step asks whether the claims are directed to patent-ineligible subject matter, such as an abstract idea. *Alice*, 134 S. Ct. at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 132 S. Ct. 1289, 1296-97 (2012)). If so, the second step asks whether the claims contain an "inventive concept," *i.e.*, an element or combination of elements sufficient to ensure that the claims amount to significantly more than a patent upon the abstract idea itself. *Alice*, 134 S. Ct. at 2355, 2357.

An "inventive concept" must be more than "well-understood, routine, conventional activity." *Id*. at 2357, 2359. The "mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention." *Id*. at 2358. "Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of additional feature that provides any practical assurance that the process is more than a drafting effort designed to monopolize the abstract idea itself." *Id*. Claims that fail the two-step *Alice* test must be invalidated. *Id.* at 2354-2355, 2360.[5]

The '005 patent is invalid because it is directed to the abstract idea of providing a replication of a printed publication that allows a user to obtain additional information about its content, and its implementation using conventional computers and routine Internet functionality fails to provide an "inventive concept."

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[5] Claim construction is not required to conduct a Section 101 analysis. *See, e.g., CLS Bank Int'l v. Alice Corp. Pty.*, 717 F.3d 1269, 1275 (Fed. Cir. 2013) *aff'd*, 134 S. Ct. 2347 (invalidating patents as directed to ineligible subject matter without performing claim construction); *Content Extraction*, 776 F.3d at 1349 ("[C]laim construction is not an inviolable prerequisite to a validity determination under § 101."). This Court has recognized that where, as here, there are no underlying material factual disputes, a case may be properly disposed of under Section 101 without the need for claim construction. *See Clear with Computers, LLC v. Altec Indus., Inc.*, No. 6:14-cv-00079, 2015 WL 993392, at *3 (E.D. Tex. Mar. 3, 2015) ("The Court does not need to accept [movant's] characterization or assertion and can formulate a characterization of the claims without construing the claims.").

A. The Claims of the '005 Patent Are Directed to an Abstract Idea

The first step of the *Alice* test considers whether the claims are directed to an abstract idea. Claims that are directed to an "abstraction – an idea, having no particular concrete or tangible form" – are not patent eligible. *Ultramercial v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014). Abstract ideas include, for example, ones that are "'fundamental … practice[s] long prevalent in our system.'" *Intellectual Ventures I LLC v. Capital One Bank*, 792 F.3d 1363, 1369 (Fed. Cir. 2015) (citing *Alice*, 134 S. Ct. at 2356).

Here, the claims of the '005 patent merely recite the steps necessary to perform the abstract idea of providing a replication of a printed publication that allows a user to obtain additional information about its content. The preamble of claim 1 broadly recites the idea of a "method for ***providing*** … [a] ***replication of*** … a corresponding ***physical publication***." *See* Vakil Decl. Ex. 1, at 33:31-33 (emphasis added). The first step of the method involves associating the original physical publication and the replication with a "page number." *See id*. at 33:34-36. The second step requires that a host computer receive the page number associating the two publications as an input. *See id*. at 33:43-44. The third and final step entails the host computer providing the user with the corresponding "replication" of the "physical publication" in response to receiving the input from step two. *See id*. at 33:45-48. The "replication" of the "physical publication" allows the user to obtain "additional information" about the content of the publication. *See id*. at 33:57-60. Though there are additional limitations in the claims, the elements of "associating," "receiving," and "providing" comprise the majority of the steps that only describe the process necessary to perform the abstract idea. *See Ultramercial*, 772 F.3d at 714-15 (disregarding certain limitations that "add a degree of particularity" where "the concept embodied by the majority of the limitations described only the abstract idea").

The specification confirms that the claims are directed to an abstract idea. The alleged invention is directed to the "severe limitation on the depth of content provided by traditional visual media," such as printed publications. *See* Vakil Decl. Ex. 1, at 1:53:54. The inventors purport to solve this problem by providing to consumers an electronic replication of "catalog pages … or pages of a book" (physical publication) that allows the "consumer to ***quickly locate additional information*** regarding aspects of the visual media object." *Id*. at 3:39-43, 12:29-34 (emphasis added). Thus, the very purpose of the patent is directed to the abstract idea.

The claims themselves describe any process a human would take to provide a replication of a printed publication that allows a user to obtain additional information about its content. *See Content Extraction & Transmission LLC v. Wells Fargo Bank*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (claims drawn to abstract idea where the elements described long-standing banking practices performed by humans, such as reviewing checks, recognizing information on the checks, and storing that information in bank records). The abstract concept underlying the claims is an age-old practice that dates back decades, if not centuries, to the advent of annotated versions of literary works.

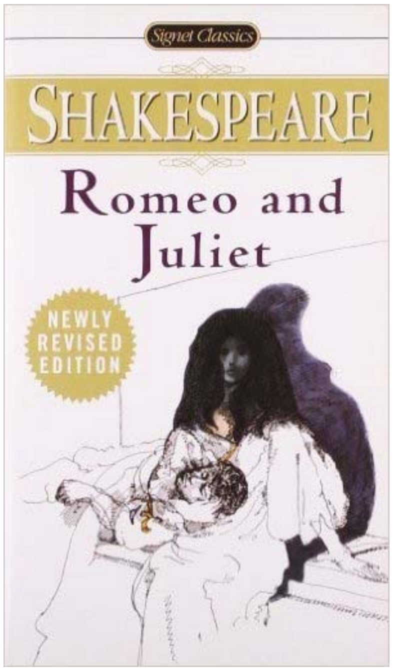
Moreover, reciting the steps as performed by a "host computer," "web server," or a generic "computer readable medium" do not elevate the claims out of abstraction. *See Content Extraction*, 776 F.3d at 1347 (an abstract idea long performed by humans is no less abstract when performed on a computer). Thus, the asserted claims are not directed to patent-eligible subject matter, but rather a "'broad concept long-practiced in our society.'" *See Intellectual Ventures*, 792 F.3d at 1369-1370 (claims for displaying an interactive web interface based on user location and activity were directed to abstract idea of customizing information long-practiced by television and newspaper industry).

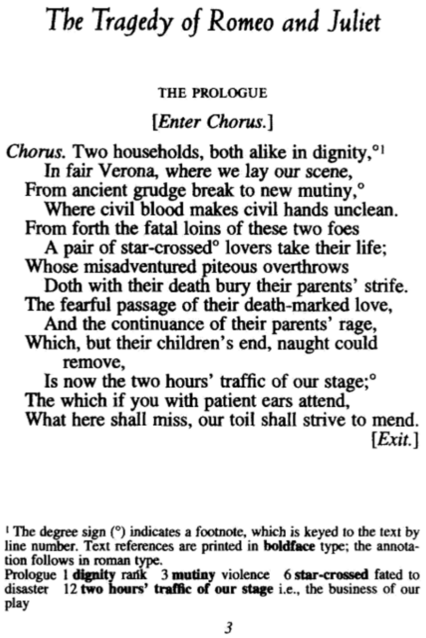
1. Publishers Have Practiced the Abstract Idea by Annotating Literary Classics for Over a Century

Well before computers and the Internet, publishers practiced the abstract idea by distributing annotated versions of classic literary works.[6] For example, in creating an annotated version of a Shakespearean play, a publisher replicates the original work (physical publication) and adds footnotes or legends to the original text that readers can access for additional information, such as definitions, explanations, or historical context, about the content of the literary work. One such example is illustrated below[7]:

[6] Publishers have distributed annotated replications of classical literature as early as the 1800s. *See, e.g.*, William Shakespeare, *The Dramatic Works of William Shakspeare* 295 (W.H. Davenport Adams ed., 1876), https://books.google.com/books?id=ZgQOAAAAQAAJ&pg=PA294&dq=annotated+taming+of+the+shrew&hl=en&sa=X&ved=0ahUKEwiXlNmD66LKAhUHvhQKHRq_AGEQ6AEIJzAC#v=onepage&q&f=true.

[7] William Shakespeare, *Romeo and Juliet* (J.A. Bryant Jr. & Sylvan Barnet eds., 2nd ed. 1998).





The Tragedy of Romeo and Juliet

THE PROLOGUE

[*Enter Chorus.*]

Chorus. Two households, both alike in dignity,°[1]
In fair Verona, where we lay our scene,
From ancient grudge break to new mutiny,°
Where civil blood makes civil hands unclean.
From forth the fatal loins of these two foes
A pair of star-crossed° lovers take their life;
Whose misadventured piteous overthrows
Doth with their death bury their parents' strife.
The fearful passage of their death-marked love,
And the continuance of their parents' rage,
Which, but their children's end, naught could remove,
Is now the two hours' traffic of our stage;°
The which if you with patient ears attend,
What here shall miss, our toil shall strive to mend.
[*Exit.*]

[1] The degree sign (°) indicates a footnote, which is keyed to the text by line number. Text references are printed in **boldface** type; the annotation follows in roman type.
Prologue 1 **dignity** rank 3 **mutiny** violence 6 **star-crossed** fated to disaster 12 **two hours' traffic of our stage** i.e., the business of our play

3

Publishers associate the original publication of the Shakespearean play with the annotated versions through the Title, Act, and Scene, and line number. Each Title, Act, Scene, and line creates an association between the original publication (prose) and the replication (annotated prose). A reader of the annotated prose can look for the Title, Act, Scene, and line they wish to view with the additional information available in the annotated notes. This abstract idea has been practiced for over at least a century.

2. Retailers Have Practiced the Abstract Idea by Providing Product Catalogs and Telephone Sales Representatives for Decades

Retailers have long practiced the abstract idea by providing telephone sales representatives to support their printed product catalogs. For example, as shown in the Sears 1975 Christmas Wish Book catalog cover below[8], Sears distributes to its customers printed product catalogs, the printed publications. Sears telephone sales representatives replicate the product catalogs by combining the printed product catalogs with additional

[8] Sears, Roebuck and Co., *Sears Wish Book for the 1975 Christmas Season* (1975), http://www.wishbookweb.com/.

product information (such as sizing options, purchase plans, and care instructions). These sales representatives associate the product catalog with the additional information about the products by using the catalog's edition, page number, and/or product identification number. Customers have long been able to call the Sears customer service phone numbers to obtain additional information about a specific product by referring to the catalog edition, page number, or product identification number. Once again, this abstract idea has been used by Sears (and other retailers) for decades.

Sears
Wish Book for the 1975 Christmas Season
IT'S SO EASY TO SHOP BY PHONE FROM ANY SEARS CATALOG
Just call Sears and say you want to place a catalog order
You can also apply by phone for a Sears Credit Card to make Sears Catalog or Retail shopping easier yet

B. The Claims of the '005 Patent Lack an Inventive Concept

The claims of the '005 patent fail the second step of the *Alice* test because the limitations do not contain an "inventive concept." The claim elements alone or as an ordered combination do not transform the claimed abstract idea into patent-eligible subject matter because they do nothing more than state the abstract idea and apply it using conventional computing tools. *See Alice,* 134 S. Ct. at 2357-60. Generic, high-level limitations such as these, which provide no guidance or restriction on how they are accomplished, do not provide an inventive concept. *See, e.g., Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1348-49 (Fed. Cir. 2015) (invalidating claims that failed to describe the mechanism for accomplishing the stated inventive concept).

1. Claim 1's "Interactive and Electronic Replication" Is Not an Inventive Concept

The claimed "interactive and electronic replication" of a printed publication does not provide an inventive concept because it is a highly generic description of a step in the abstract idea itself. At best, the claims only describe that a replication is "interactive" because it allows users to obtain additional information about its content. *See* Vakil Decl. Ex. 1, at 33:57-60 ("the interactive … replication enabling the user to obtain additional information on the … products"). The claims only describe that a replication is "electronic" because it is transmitted to the user from a computer. *See* Vakil Decl. Ex. 1, at 33:45-46 ("providing from the host computer the … electronic replication"). Yet, the limitations do not describe, or restrict, ***how*** to interactively provide the additional information or ***how*** to create the electronic replication.

This is improper. The Federal Circuit has repeatedly held that such generic and high-level descriptions of elements with no concrete or tangible form impart no meaningful limitation to the claims. *See, e.g., Internet Patents*, 790 F.3d at 1348 (ineligible claims described the result of the elements directed to the abstract idea without any restriction on how the result is accomplished); *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012) (ineligible claims failed to "specify how the computer [components] are specially programmed to perform" the abstract idea of an information clearinghouse).

Moreover, the specification confirms that the process of replicating a printed publication is accomplished through the use of generic and conventional computer equipment, such as a scanner or digital camera. *See* Vakil Decl. Ex. 1, at 4:60-65. The use of conventional computer devices performing in a known manner does not provide an inventive concept. *See Ultramercial*, 772 F.3d at 715 (additional features to abstract idea must be more than well-understood, routine, conventional activity to transform abstract idea into patent-eligible subject matter) (internal quotations omitted). It is also well-settled that the use of a generic scanner and computer to create a duplicate of a printed document are well-understood, routine and conventional activities. *Content Extraction*, 776 F.3d at 1347-1348 (use of existing scanning or other digitizing device technology to recognize and store data is well-known use of such technology and thus does not involve more than the performance of well-understood, routine, and conventional activities in the industry).

Finally, the ’005 patent does not purport, either in the claims themselves or in the specification, to have invented a new machine or software to allow information to be added to an electronic image or for digitizing printed publications. Therefore, the “interactive and electronic replication” of claim 1 amounts to no more than reciting the abstract idea of providing a replication of a printed publication that allows a user to obtain additional information about its contents. *See Ultramercial*, 772 F.3d at 715.

2. Claim 1’s Generic Computer Functions Do Not Provide an Inventive Concept

Claim 1 of the ’005 patent sets forth three steps, all of which are basic computer functions: associating, receiving, and providing (or transmitting[9]). *See* Vakil Decl. Ex. 1, at claim 1. Each of these limitations recites only the conventional use of a generic, unspecialized computer and do not provide an inventive concept. *Alice*, 134 S. Ct. at 2358-60 (conventional use of a generic computer to implement an abstract idea does not transform an abstract idea into patent-eligible subject matter); *Ultramercial*, 772 F.3d. at 714-17 (generic computer implementation of the abstract idea with conventional activity is insufficient to supply an inventive concept).

a. "Associating" Is a Generic Computer Function That Does Not Supply an Inventive Concept

As the Federal Circuit has recognized, the claimed step of "associating" data with an identifier, such as a page number, is nothing more than conventional computer functionality. *See Intellectual Ventures*, 792 F.3d at 1368 (recited limitation of data "associated" with "profile keyed to a user identity" was generic computer element); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1368 (Fed. Cir. 2011) (ineligible claims recited matching transaction information to detect fraud). Moreover, the patent states that the step of "associating" can be accomplished by a "conventional" personal computer and computer components. *See, e.g.*, Vakil Decl. Ex. 1, at 9:28-29, 8:38-40. Thus, the first step of using a generic computer to associate the interactive and electronic replication with an identifier, like a page number, does not provide an inventive concept. *See Alice*, 134 S. Ct. at 2358-60.

b. "Receiving," "Providing," and "Transmitting" Are Generic Computer Functions That Do Not Supply an Inventive Concept

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[9] *See* Vakil Decl. Ex. 1, at 4:25-26 ("the [interactive electronic replication] is ***transmitted*** to the web browser for display to the user") (emphasis added), 4:52-54 ("In response to receiving [a request], the voice system may ***transmit*** an [interactive electronic replication] to the user") (emphasis added).

"Receiving" a request for data and "providing" or "transmitting" that data in response describe generic computer functions that the Federal Circuit has held are "not even arguably inventive." *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. Sep. 3, 2014) (finding "receiv[ing] a request" and "transmit[ting]" information in return to be generic computer functionality); *see also Ultramercial*, 772 F.3d at 715-17 (finding that all eleven steps of the claimed method, including "receiving" and "providing" are routine, conventional activities of a general purpose computer). Further, the '005 patent discloses that the steps of "receiving" and "transmitting" data are performed by ***conventional*** computing operations and structures. *See, e.g.*, Vakil Decl. Ex. 1, at 8:38-40, 9:28-30, 10:48-50; 10:7-10. Accordingly, the patentee's description of such elements as "conventional" confirms that the limitations do not provide an inventive concept. *See Internet Patents*, 790 F.3d at 1348.

3. The Elements as an Ordered Combination Do Not Provide an Inventive Concept

In combination, the elements of claim 1 "ad[d] nothing … that is not already present when the steps are considered separately." *See Alice*, 134 S. Ct. at 2359. As explained above, each element involves conventional functionality of a generic computer or device, and nothing unexpected or non-routine occurs through the use of these conventional computer components. Claim 1 merely recites the typical order of making a replication accessible by associating the new electronic replication with the original printed publication, receiving a request for the new electronic replication, and finally providing the electronic replication that allows the user to obtain additional information. Taken together as an ordered combination, therefore, the elements of claim 1 do not supply an "inventive concept." *See Alice*, 134 S. Ct. at 2359-60.

C. Claims 2-21 Also Fail to Provide an Inventive Concept to the Abstract Idea

The remaining claims of the ’005 patent also fail the second step of the *Alice* test because none of them contain an “inventive concept.” The remaining claims include the three core limitations of “associating,” “receiving,” and “providing,” and are directed to the same abstract idea of providing a replication of a printed publication that allows a user to obtain additional information about its content. *See Content Extraction*, 776 F.3d at 1348 (every claim need not be individually addressed if representative claim is identified and “all the claims are substantially similar and linked to the same abstract idea”). Merely adding conventional limitations does not meaningfully change the scope of the claims. *See Alice*, 134 S. Ct. at 2357, 2359.

1. Claims 2, 8, 9, and 10 Merely Dictate Generic Types of “Additional Information”

Claims 2, 8, 9, and 10 depend from claim 1, and further recite types of “additional information” about the content of the publication that is available to the user within the replication. *See* Vakil Decl. Ex. 1, at claims 2, 8, 9, 10. The type of additional information specified in the claims – store location (claim 2), an additional graphic object (claim 8), multimedia object (claim 9), or text (claim 10) – are all familiar to the advertisement industry or conventional computer technology. The listing of additional information that can be provided to the user is at best a limitation on the use of the abstract idea to a particular technological environment or field of use, which is insufficient to supply an inventive concept. *See buySAFE*, 765 F. 3d at 1355 (narrowing claims to familiar concepts within the industry are insufficient to supply an inventive concept).

2. Claims 3-6, 11, and 12 Add Routine Data-Gathering Steps

Claims 3-6, 11, and 12 also depend from claim 1, and add routine and conventional data-gathering steps taken by a generic computer that do not amount to an inventive concept. The claims recite the steps of "collecting … user purchase information" (claim 3), "sending … collected user purchase information" (claim 4), "processing … a user's online purchase" (claim 5), "storing a user's … information" (claim 6), "receiving a user's interaction" (claims 11 and 12). These steps simply amount to insignificant "data-gathering" steps that confer no inventive concept to the claims. *Ultramercial*, 772 F.3d at 716 (updating activity log constituted insignificant "data-gathering steps"); *OIP Tech., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (collecting statistics about customer behavior and the number of product sales were "routine data-gathering steps"). The Federal Circuit has found that "collecting," "sending," "processing," "storing," and "receiving" data are similarly conventional computer functions describing the well-known concept of data collection performed by generic computers and thus are insufficient to supply an inventive concept. *See, e.g.*, *buySAFE*, 765 F.3d at 1355 (concluding that a computer "receiving" a request and "processing" the request "with no further specification – is not even arguably inventive").

3. Claim 7 Recites Conventional Internet Functionality

Claim 7 depends from claim 1, and specifies that an "internet address" is visible with the page number, and the host computer receives the "input representing the page number" through a website. *See* Vakil Decl. Ex. 1, at claim 7. Merely stating that an "internet address" is visible and an input is made through a "website" recites generic Internet functionality that the Federal Circuit has stated does not provide an inventive concept. *Ultramercial*, 772 F.3d at 716 (routine use of the Internet does not transform an otherwise abstract idea into patent-eligible subject matter).

4. Claim 13 Includes Generic, High-Level Limitations

Claim 13 depends from claim 1, and further states that the interactive and electronic replication "enables a user to initiate an online purchase of the [] product." *See* Vakil Decl. Ex. 1, at 34:53-54, 60-61. This is not an inventive concept because, as described above with the Sears catalogs, allowing users to initiate a purchase of products is practice familiar in the advertising industry. *See supra* Section IV.A.2. Claim 13 does no more than add the routine step of using the Internet for this conventional practice, and thus is insufficient to supply an inventive concept. *See buySAFE*, 765 F.3d at 1355.

Claim 13 also states that the interactive and electronic replication includes "selectable portions" that users can select to access the "additional information" in the interactive and electronic replications. *See* Vakil Decl. Ex. 1, at 34:48-52, 55-59 ("interactive electronic replication includes a [first/second] selectable portion and "selection of the [first/second] selectable portion provides additional product information"). This generic and high-level limitation fails to describe, or restrict, how to make portions of the interactive and electronic replication "selectable," rendering the claims ineligible. *See Internet Patents*, 790 F.3d at 1348. Moreover, the patent confirms that this limitation is conventional. The specification contemplates that interactive and electronic replications are "selectable" by being "hot-linked" to the additional information, which is merely the conventional Internet function of hyperlinking. *See, e.g.*,Vakil Decl. Ex. 1, at 4:9-11; 15:7-9; 16:19-27; 15:52-55 ("if a digital graphic object 702 is 'hot-linked' to another Internet site, the user can 'click on' the digital graphic object 702 and the browser will move to another [] Internet site"). The limitation thus does not provide an inventive concept.

5. Claim 14 Recites Web Servers and Host Computers, Which Are Generic Computer Components

Claim 14 is the only other independent method claim, and it merely adds that a web server executed by the host computer performs the step of "receiving an input" in claim 1. *See* Vakil Decl. Ex. 1, at claim 14. As the patent confirms, the web server used to implement the claimed invention is generic, functional equipment. *See id.* at 8:42-48, 10:7-16, 10:48-56. Further, the "receiving" function performed by the web server is a basic function and a routine use of the Internet. *See id.* at 8:42-48, 10:7-10, 10:48-56, 13:59-66. The Federal Circuit has repeatedly held that using generic computer components, such as a web server, to perform basic Internet functions, like "receiving" inputs and "sending" data, does not transform an abstract idea into patent-eligible subject matter. *See buySAFE*, 765 F.3d at 1355.

6. Claims 15-21 Mirror the Language of the Patent-Ineligible Method Claims

Claims 15-21 are system and "computer-readable medium" claims that mirror the steps of the method claims. *See* Vakil Decl. Ex. 1, at claim 15-16 (system claims that use a generic "host computer" and "web server" to perform same method of "associating," "receiving," and "providing"), claims 17-21 (computer-readable medium containing program code for performing the same method of "associating," "receiving," and "providing"). The claims do not provide an inventive concept because they recite "generic computer components to implement the same idea" as the method claims and offer no "meaningful limitation beyond generally linking the use of the claimed method to a particular technological environment." *See Alice*, 134 S. Ct. at 2360; *see also Accenture Global Servs. GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1342 (Fed. Cir. 2013) (no meaningful limitation beyond generally linking the use of the method to a particular technological environment when system claims are simply the method claims implemented on a system for performing the method). Accordingly, claims 15-21 are invalid as directed to unpatentable subject matter, just like the method claims. *See Accenture*, 728 F.3d 1344 (system and method claims which contain only minor differences in terminology but require performance of the same basic process should rise or fall together); *eDekka*, 2015 WL 5579840, at *5 (holding system claims invalid for same reasons as method claims because system claims "mirror the language of the method claims").

D. The '005 Patent Claims Are Fundamentally Different from the Claims in *DDR Holdings*

Finally, *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014) – the lone post-*Alice* Federal Circuit decision to find claims patent-eligible – is inapposite. In *DDR Holdings*, the Federal Circuit upheld claims creating a hybrid website when a user of a host website clicked on a hyperlink, rather than sending the user away from the host website to a separate third-party website. *DDR Holdings*, 773 F.3d at 1257. The Court held that the claimed solution was "rooted in computer technology" and "recite[d] an invention that [was] not merely the routine or conventional use of the Internet." *Id.* at 1258-59.

The claims of the '005 patent are unlike the claims in *DDR Holdings* because they: (1) do not seek to address a problem particular to the Internet; and (2) recite nothing but conventional operations of computing and Internet technology. *See Intellectual Ventures*, 792 F.3d at 1371 (distinguishing *DDR Holdings* from invalid claims on similar grounds). The claims merely recite a pre-computing practice of providing a replication of a printed publication that allows a user to obtain additional information about its content, along with routine and conventional use of "a host computer" and "a web server application" to perform that idea. *See supra* Section IV.A. The patent does not claim to address any Internet-centric technical challenge, but instead merely allows "consumers to quickly locate additional information regarding aspects" of printed publications and, thus, at best, achieves the concept more quickly on the Internet. *See* Vakil Decl. Ex. 1, at 3:39-42. The patent also uses routine technology in a conventional manner that existed long before the asserted patent. *See supra* Section IV.B, C. Thus, *DDR Holdings* is distinguishable from the '005 patent claims and further supports that the claims are directed to patent-ineligible subject matter.

V. CONCLUSION

The claims of the '005 patent are invalid as directed to non-patentable subject matter because they are directed to an abstract idea of providing a replication of a printed publication that allows a user to obtain additional information about its content. The claims merely implement the idea using conventional computers and routine Internet functionality that fail to provide an "inventive concept." Therefore, Walmart Stores, Inc. and Walmart.com USA, LLC respectfully request that this Court grant this motion and dismiss Tangelo IP, LLC's complaint with prejudice.

Dated: January 15, 2016 Respectfully submitted,

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WAL-MART.COM USA, LLC

[10] As stated in note 1, *supra*, Tangelo incorrectly named "Wal-Mart.com, Inc.," which does not exist, as a Defendant.

CERTIFICATE OF COMPLIANCE WITH THE COURT'S 35 U.S.C. § 101 MOTION PRACTICE ORDER

_______ The parties **agree** that prior claim construction is not needed to inform the Court's analysis as to patentability.

__X__ The parties **disagree** on whether prior claim construction is not needed to inform the Court's analysis as to patentability.

On January 15, 2016, I met and conferred with John Edmonds, lead counsel for Tangelo IP, LLC, on whether prior claim construction is needed to inform this Court's analysis as to patentability. We disagreed on whether prior claim construction is necessary to inform this Court's analysis as to patentability.

/s/ Bijal V. Vakil
Bijal V. Vakil

CERTIFICATE OF SERVICE

I hereby certify that counsel of record who are deemed to have consented to electronic service are being served on January 15, 2016, with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3). Any other counsel of record will be served by First Class U.S. Mail on this same date.

/s/ Bijal V. Vakil
Bijal V. Vakil